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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,771	06/24/2005	Toshiro Kinoshita	970.1012	7143
21171 7590 05/12/2008 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER HIGGINS, GERARD T	
			ART UNIT	PAPER NUMBER
			1794	
			MAIL DATE	DELIVERY MODE
			05/12/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/540,771

**Applicant(s)**

KINOSHITA ET AL.

**Examiner**

GERARD T. HIGGINS

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.  
4a) Of the above claim(s) 7-13 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-6 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 24 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 06/24/2005  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I, claims 1-6 in the reply filed on 02/11/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 7-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 02/11/2008.

### *Priority*

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

4. The disclosure is objected to because of the following informalities:
  - a. The word "included" is used at multiple places where the word "including" should be used. It appears at many places including page 3, lines 7 and 12.
  - b. The words "polycrystallizing" and "decrystallizing" at page 13, line 11 are not correct.

Appropriate correction is required.

5. The use of the trademark BLU-RAY DISC has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Objections***

6. Claims 1 and 2 are objected to because of the following informalities: the word "included" should probably be "including." Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

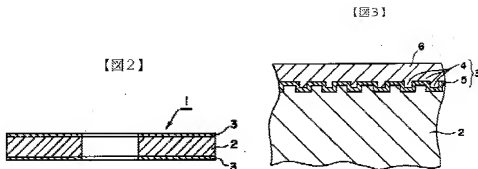
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Otomo (JP 2000-011448), machine translation included.

Otomo teaches the invention of Figures 2 and 3.



Otomo teaches that polycarbonate in the substrates of optical recording media are harmful for the environment [0002]. He plans to rectify this by making the substrate of the optical recording medium out of biodegradable resins [0005] and [0006]. He teaches that a biodegradable resin include polypropylene [0009] or BIONOLLE [0010], which are also proposed in applicants' specification. The optical disc 1 has a substrate 2 of biodegradable resin and a recording layer 3 formed on both sides of the substrate [0018]. The recording layer 3 has a base material layer 6. Otomo teach that the base material layer 6 is formed using the same plastic material as the substrate 2. Applicants state in their specification at page 9, line 20 to page 10, line 4 that the non-hydrophilic film is preferentially composed of the same types of resin that is in the biodegradable substrate layer; therefore, the base material layer of Otomo is inherently a non-hydrophilic layer (hydrophobic).

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

Art Unit: 1794

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo (JP 2000-011448).

Otomo teaches all the limitations of applicants' claim 1 in section 8 above; however, he fails to teach a protective layer for protecting the recording layer.

It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to merely duplicate the base material layer **6** in order to provide extra water fastness and abrasion resistance for the recording layer.

11. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo (JP 2000-011448) in view of Matsuishi et al. (5,972,457).

Otomo teaches that polycarbonate in the substrates of optical recording media are harmful for the environment [0002]. He plans to rectify this by making the substrate of the optical recording medium out of biodegradable resins [0005] and [0006]. He teaches that a biodegradable resin include polypropylene [0009] or BIONOLLE [0010], which are also proposed in applicants' specification. The optical disc **1** has a substrate **2** of biodegradable resin and a recording layer **3** formed on at least one side of the substrate [0018]. The recording layer **3** has a base material layer **6**. Otomo teach that

the base material layer **6** is formed using the same plastic material as the substrate **2**. Applicants state in their specification at page 9, line 20 to page 10, line 4 that the non-hydrophilic film is preferentially composed of the same types of resin that is in the biodegradable substrate layer; therefore, the base material layer of Otomo is intrinsically a non-hydrophilic layer (hydrophobic); however, Otomo fails to teach a printing layer provided on the opposite side of the substrate on which the recording layer is provided wherein the printing layer has a base material layer comprised of a non-hydrophilic film and a protective layer for protecting the recording layer.

With regard to the fact that the Examiner is removing a recording layer from one side of the optical recording disc **1** and replacing it with a printing layer, it has been held that "omission of an element and its function is obvious if the function of the element is not desired." Please see MPEP 2144.04 and *Ex parte Wu*, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989). Making a dual-sided optical recording medium into a single-sided optical recording medium would not produce an unobvious result; further, one of ordinary skill in the art of optical recording media are well versed in preparing single-sided dual-recording layer media, dual-sided dual-recording layer media, or any other possible combination.

Matsuishi et al. teach a printable optical recording medium, which has a protective layer (base material layer) and an ink-receiving layer (Abstract). They teach at col. 7, lines 25-30 that the base material layer and ink-receiving layer may be combined with each other or they may include a plurality of layers. They teach at col. 9, lines 45-51 the properties of their ink-receiving/base material layers, which include *inter*

Art Unit: 1794

*alia* water resistance (hydrophobic) and hardness (abrasion resistance). The ink-receiving layer may be used in conjunction with oil-based inks (col. 10, lines 21-25); further, they teach at col. 11, lines 17-46 that the polymers in their base material layer and ink-receiving layer have a higher hydrophobic property than prior art receiving layers/base material layers. From all of this evidence, the Examiner deems that the base material layer of Matsuishi et al. intrinsically comprises a non-hydrophilic (hydrophobic) film.

Since Matsuishi et al. and Otomo are both drawn to optical recording media, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the protective layer and ink-receiving layers of Matsuishi et al. in the optical disc of Otomo. The results of which would have been completely predictable to one having ordinary skill; further, the components would have performed the same in combination as they had separately. Another motivation for combining these references would be to lead to an optical disc that was customizable by the consumer.

With regard to claim 4, it has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

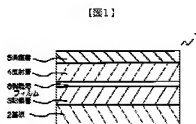
It would have been obvious to one having ordinary skill in the art at the time the invention was made to merely duplicate the base material layer 6 in order to provide extra water fastness and abrasion resistance for the recording layer.



12. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo (JP 2000-011448) in view of Matsuishi et al. (5,972,457), as applied to claim 2, further in view of Ota (JP 2000-030302), machine translation included.

Otomo in view of Matsuishi et al. render obvious all of the limitations of applicants' claim 2 in section 11 above; however, they fail to disclose a release layer provided between the substrate and the recording layer or between the substrate and the printing layer.

Ota teaches the device of Figure 1.



The device has a release layer **6** disposed in between the recording layer **3** and a substrate **5** [0014].

Since Otomo, Matsuishi et al. and Ota are all drawn to optical recording media, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the release layer of Ota in between the substrate and recording layer of the medium of Otomo in view of Matsuishi et al. The results of this combination would have been completely predictable to one having ordinary skill in the art of optical recording media; further, each of the components would perform the same in combination as they did separately. Another motivation for combining these references can be found in Ota at [0021], which discloses that the release provide an

extra level of security, wherein the information of the optical disc can be completely destroyed at the time of disposal; further, one of ordinary skill would recognize that this would allow for separation and potential recycling of the individual layers of the optical recording medium.

With regard to claim 6, it has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

It would have been obvious to one having ordinary skill in the art of optical recording media to include a release layer at any position in the optical recording medium strata, including in between the printing layer and the substrate as claimed. A motivation for doing so would be additional security as it would allow one to dispose of the printing layer, which might have important information thereon, or for affording separation and potential recycling of the individual layers of the optical recording medium.

### ***Conclusion***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 7:30am-5pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner  
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